

## **REMARKS**

Claims 1-49 are pending in the instant application and stand rejected by the examiner. Claims 1 and 39 are independent claims. The assignee traverses the rejections of the pending claims.

### ***Claim Rejections – 35 U.S.C. §§ 102, 103***

Claims 1-8, 21-27, 33-34, and 39-48 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Network Working Group RFC 2633 (June 1999) (Ramsdell) and in further view of Klein (U.S. Patent No. 6,496,853). Claims 9-14, 16-17, 28-32, and 38 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ramsdell in view of Klein and in further view of Thorne (U.S. Patent No. 5,958,005). Claims 15 and 19-20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ramsdell in view of Klein and Thorne and further in view of official notice. Claim 18 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Ramsdell in view of Klein and Thorne and further in view of Carpenter (U.S. Patent No. 5,544,316). Finally, claim 49 stands rejected under 35 U.S.C. § 103 (a) as being unpatentable over Ramsdell in view of Klein and in further view of official notice. These rejections are traversed.

#### **Claim 1**

Claim 1 of the instant application is directed to a method of mimetic message settings selection on a messaging client. The method detects an outgoing message and determines whether the outgoing message is related to a previously received message having message characteristics. Claim 1 specifically requires that the determining of whether an outgoing message is related to a previously received message is based on the message content of the outgoing message. None of the cited portions of the references (Ramsdell and Klein) looks to

the message content of the outgoing message at all. Ramsdell looks to the specified recipient of a message in selecting an encryption setting. Klein teaches how an incoming message can be processed before it is viewed by a recipient. More specifically, an **incoming message** is compared with other **received messages** so that messages with redundant contents can be managed so that the user need not review the content. Neither of these references examines the message content of the outgoing message.

35 U.S.C. § 103(a) states that a "patent may not be obtained... if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." To make a case for obviousness, the office must present evidence that each claim feature was known and give reasons why one skilled in the art would find the combination of those features obvious. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

While multiple references may be cited to in rejecting a claim for obviousness, each feature of the claim must be taught or suggested either explicitly or inherently. Claim 1 requires an evaluation of the message content of the outgoing message to determine if the outgoing message is related to a previously received message. None of the cited portions of Ramsdell or

Klein consider the message content of an outgoing message at all. Because the cited references do not teach looking to the message content of an outgoing message, one skilled in the art having both references would not combine them to generate the claimed method, which requires looking to the message content of the outgoing message, absent the teachings of the application at issue. Because the cited art lacks a teaching or suggestion of a determination of whether an outgoing message is related to a previous message based upon an analysis of the message content of an outgoing message, it is respectfully requested that the § 103 rejection of claim 1 be withdrawn.

### **Claim 39**

With respect to the other independent claim, claim 39 recites similar subject matter as claim 1. Accordingly, for similar reasons as claim 1, claim 39 is allowable and should proceed to issuance.

### **Claim 3**

Assignee disagrees with other positions in the office action as well. For example, claim 3 recites that a received message includes an attachment and that the step (in claim 1) of determining whether an outgoing message includes a portion of a previously received message comprises determining whether the outgoing message includes the attachment. In rejecting this claim, the office action cites Ramsdell in view of Klein. More specifically, the office action cites to column 11, lines 43-52 and column 9, lines 6-9 of Klein as teaching the attachment feature of claim 3. However, the processing disclosed in these passages of Klein is only discussing the processing of received messages and does not involve at all the processing of an outgoing message as required by claim 3. Moreover, Klein is merely discussing that attachments can be added to a message, and there is no discussion of the specific features of claim 3 (i.e., wherein the step of determining whether the outgoing message includes a portion of a previously received

message comprises the step of determining whether the outgoing message includes the attachment). For at least this additional reason, claim 3 is patentable over the cited references and should proceed to issuance.

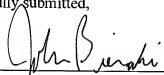
It is noted that the assignee has not presented arguments herein with respect to the other dependent claims in the instant application. This is done without prejudice to the assignee's right to present arguments regarding each of the dependent claims at any point in the future. Further, since all of the dependent claims in the instant application depend from independent claims that are patentable over the cited references, the dependent claims are themselves patentable for at least the reasons set forth with respect to the independent claims.

### CONCLUSION

For the foregoing reasons, the assignee respectfully submits that the pending claims are allowable. Therefore, the assignee respectfully requests that the examiner pass this case to issuance.

Respectfully submitted,

By: \_\_\_\_\_

  
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